Remarks

This is a Response to the Official Action dated March 11, 2005.

Claims 1-19 are currently pending in the Application.

Claims 1-19

This response amends Claims 1 and 12 to clarify the scope of the invention. Support for the amendments can, for example, be found on page 5 line 27 to page 6, line 12 of the specification.

35 U.S.C. §101 Rejection

Claims 1-11 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicant submits that Claim 1 has been amended to overcome the rejection and respectfully request that the rejection be withdrawn.

35 U.S.C. §102(b) Rejection

Claims 1-19 stand rejected under 35 U.S.C. §102(b) as being anticipated by David Pogue "PalmPilot: The Ultimate Guide" (herein after "Pogue"). Applicant respectfully disagrees.

The Examiner is reminded that "[a] claim is anticipated only if each and every element as set forth in the clam is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 quoting *Verdegaal Bros. V. Union Oil Co, of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Examiner is also reminded that "[the] identical invention must be shown in as complete detail as is contained in the ... claim." MPEP 2131 quoting *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicant submits that Pogue does not teach each and every element as set forth in the rejected claims. In particular:

Claim 1

A. Applicant submits that Pogue does not disclose, suggest or teach, *inter alia*, at least the following features recited by Claim 1, as amended, of the present application:

> "a pre-process agent for receiving a query signal to query identity information for the last message in the database ... a mail agent for outputting the query signal"

The Examiner asserts that "a pre-process agent for receiving a query signal to query identity information for the last message in the database" as recited in Claim 1 is disclosed by Pogue's "when you tap Check & Send, the Palm VII sends all email you've written, but receives only the first ten incoming messages. If you're told that more email is still waiting to be downloaded, you must tap Check & Send again." See page 3, section 5, lines 4-5 of the Office Action. Applicant respectfully traverses the Examiner's assertion for the following reasons.

The Examiner seems to misunderstand the teaching of Pogue. Pogue teaches that after the taping of the Check and Send it is the Palm VII that transmits a signal to obtain the remaining emails. Applicant is not sure how this action by the Palm VII teaches "a pre-process agent for receiving a query signal to query identity information for the last message in the database" wherein it is "a mail agent" that is used "for outputting the query signal" as recited in Claim 1. Does the Examiner consider that "a pre-process agent" and/or "a mail agent" as recited in Claim 1 are claimed to be within a PDA? Because Pogue teaches the actions performed by Palm VII, Pogue does not teach, disclose or suggest "a pre-process agent for receiving a query signal to query identity information for the last message in the database ... a mail agent for outputting the query signal" as recited in Claim 1.

Further, Applicant submits that the Examiner failed to comply with 37 C.F.R. §1.104(c)(2) which states:

> "In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes invention other than that claimed by Applicant, **the particular part relied on must be designated as nearly as practicable**. The pertinence, if not apparent, must be clearly explained and each rejected claim specified" (emphases added).

Applicant submits that the Examiner has failed to "designate as nearly as practicable" the particular part of Pogue relied upon in making the assertion that Pogue teaches "a pre-process agent for receiving a query signal to query identity information for the last message in the database ... a mail agent for outputting the query signal" as recited in Claim 1.

Hence, Claim 1 is patentable over Pogue and should be allowed by the Examiner. Claims 2-11, at least based on their dependency on Claim 1, are also believed to be patentable over Pogue.

B. Applicant submits that Pogue does not disclose, suggest or teach, *inter alia*, at least the following features recited by Claim 1, as amended, of the present application:

> "a pre-process agent for ... outputting the identity information, wherein the identity information of the last message is used to identify new messages on an incoming message server that are received after the last message"

Applicant submits that the Examiner again failed to comply with 37 C.F.R. §1.104(c)(2) by not "designate as nearly as practicable" the particular part of Pogue relied upon in making the assertion that Pogue teaches "a pre-process agent for ... outputting the identity information" as recited in Claim 1. Applicant submits that Pogue does not teach, disclose or suggest "a pre-process agent for ... outputting the identity information, wherein the identity information of the last message is used to identify new messages on an incoming message server that are received after the last message" as recited in Claim 1.

Hence, Claim 1 is patentable over Pogue and should be allowed by the Examiner. Claims 2-11, at least based on their dependency on Claim 1, are also believed to be patentable over Pogue.

C. Applicant submits that Pogue does not disclose, suggest or teach, *inter alia*, at least the following features recited by Claim 1, as amended, of the present application:

> "a pre-process agent for ... receiving an internally formatted message and storing the internally formatted message to the database ... a content converter agent for ... transforming the new message into the internally formatted message, and outputting the internally formatted message"

The Examiner asserts that "a pre-process agent for ... receiving an internally formatted message and storing the internally formatted message to the database" as recited in Claim 1 is disclosed by Pogue's paragraph describing WCPS transferring email requests to email servers, paragraph describing that Plam.Net deletes emails after 60 days, and paragraph describing that Palm.Net has a limit amount of memory for storing emails. See page 3, section 5, lines 6-8 of the Office Action. The Examiner also asserts that "a pre-process agent for ... receiving an internally formatted message and storing the internally formatted message to the database" as recited in Claim 1 is disclosed by Pogue's paragraph describing that an iMessenger used by Palm VII can be used instead of Palm Mail wherein many of the features of the iMessenger are identical to the Palm Mail. See page 3, section 5, lines 17-19 of the Office Action. Applicant respectfully traverses the Examiner's assertion for the following reasons.

Once again the Examiner seems to misunderstand the teaching of Pogue. Pogue teaches that the iMessenger the Palm VII can be used instead of the Palm Mail. See page 435, paragraphs 2-3 of Pogue. Applicant is not sure how the use of the iMessenger by the Palm VII teaches "a pre-process agent for ... receiving an internally formatted message and storing the internally formatted message to the database" wherein it is "a content converter" that is used for "transforming the

new message into the internally formatted message, and outputting the internally formatted message" as recited in Claim 1. Does the Examiner consider that "a pre-process agent" and/or "a content converter" as recited in Claim 1 are claimed to be within a PDA? Because Pogue teaches the iMessenger is within the Palm VII, Pogue does not teach, disclose or suggest "a pre-process agent for ... receiving an internally formatted message and storing the internally formatted message to the database ... a content converter agent for ... transforming the new message into the internally formatted message, and outputting the internally formatted message" as recited in Claim 1.

Further, Applicant submits that the Examiner failed to comply with 37 C.F.R. §1.104(c)(2) by not "designate as nearly as practicable" the particular part of Pogue relied upon in making the assertion that Pogue teaches "a pre-process agent for ... receiving an internally formatted message and storing the internally formatted message to the database ... a content converter agent for ... transforming the new message into the internally formatted message, and outputting the internally formatted message" as recited in Claim 1.

Hence, Claim 1 is patentable over Pogue and should be allowed by the Examiner. Claims 2-11, at least based on their dependency on Claim 1, are also believed to be patentable over Pogue.

Claim 12

At least for the reasons stated above, Pogue does not disclose, suggest or teach "a pre-process agent to receive a query signal querying identity information for the last message in the database ... a mail agent for outputting the query signal after a predetermined time interval" as recited by amended Claim 12; "a pre-process agent to ... output the identity information, wherein the identity information of the last message is used to identify new messages on the incoming message server that are received after the last message" as recited in amended Claim 12; "a pre-process agent to ... receive an internally formatted message and store the

internally formatted message to the database ... a content converter agent for ...
transforming the new message into the internally formatted message, and
outputting the internally formatted message" as recited by amended Claim 12.
Hence, Claim 12 is patentable over Pogue and should be allowed by the
Examiner. Claims 13-19, at least based on their dependency on Claim 12, are also
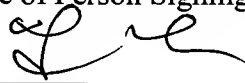believed to be patentable over Pogue.

Conclusion

In view of the above, reconsideration and allowance of all the claims are respectfully solicited.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents POB 1450, Alexandria, VA 22313-1450 on
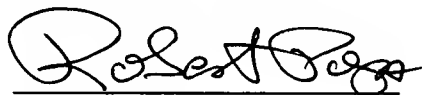
June 10, 2005
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(Date of Deposit)

Lonnie Louie
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(Name of Person Signing)

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(Signature)

June 10, 2005   6/16/05
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(Date)

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